



RECEIVED

FEB -3 2003

#19/Reply
Brief
D. Ennis
2-11-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES	
In re application of: Mellardo	Examiner: William H. Mayo, III
Serial No.: 09/295,212	Group Art Unit: 2831
Filed: 4/21/99	Docket No.: Mellardo-1 CPA
For: A CABLE ARRESTER, IN COMBINATION WITH AN ENERGIZED FLUID CONDUIT	Date: January 27, 2003

Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY BRIEF OF APPELLANT

This is a reply to the examiner's answer mailed on November 27, 2002, having a period of response set to expire on January 27, 2003. No fees are believed to be due as a result of this reply. Authorization is hereby given for any additional fees that may be due and owing in connection with this matter or for any overpayment credit to be charged to Deposit Account No. 50-2061.

I. RESPONSE TO ARGUMENTS MADE IN EXAMINER'S ANSWER

The issue in this appeal is whether claims 1-9 are unpatentable under 35 USC §103(a) over U.S. Patent 4,913,239 to Bayh, III (Bayh) in view of U.S. Patent 4,483,395 to Kramer *et al.*

(Kramer). The arguments set forth against Bayh in view of Kramer in appellant's appeal brief filed on September 24, 2002 are incorporated herein by reference.

The examiner's answer states that all three criteria for establishing a clear *prima facie* case of obviousness are present with respect to Bayh in view of Kramer. It is the appellant's position, the examiner's answer has not shown that all three criteria have been met, as there is no motivation for combining Bayh and Kramer and because Bayh in view of Kramer fail to teach all the limitations of the claims. Therefore, a *prima facie* case of obviousness of the present invention has not been established using Bayh in view of Kramer.

As mentioned in the appellant's appeal brief, the examiner's characterization of Bayh is confusing and inconsistent. The examiner's answer fails to correct this and in fact includes additional statements about the teachings of Bayh which are different and inconsistent with previous statements made by the examiner in the examiner's answer. For example, the examiner's answer essentially states on page 3 that Bayh discloses an apparatus (i.e., cable arrestor, Figs 1-6) in combination with an energized-fluid conduit (col. 1, lines 35-40) which houses a conduit 20 (Fig 1) for transporting the energized fluid conduit (col. 1, lines 35-40); a plurality of power conductors 88, 89, 90 (Fig 2C) confined within the conduit 20 and means 45 (Fig 1) removable fixed to the conduit 20 (col. 4, lines 1-4) for holding the power conductors 88, 89, 90 in a spaced apart disposition across the conduit 20. Then, on page 7 of the examiner's answer, the examiner essentially states that Bayh discloses a well casing having a submersible pump and power cables to provide electrical energy to operate the pump (col. 1, lines 35-40) wherein a connector 45 is utilized to separate the conductors for connection to the electrical motor 50 on the pump (col. 2, lines 1-11).

In any case, appellant submits that what Bayh actually discloses is a tubing string 20 having suspended therein an electrical connector 45 that is mechanically attached to a lower end of a solid mandrel 42. An upper end of the mandrel 42 is attached to a tubular housing 41 of a cable anchor assembly 40, which is suspended from a power cable 30. The power cable 30 includes a plurality of conductors 88, 89, 91 that extend into the tubing string 20 through a window 43 in the tubular housing 42 in a touching relationship, and then enter the electrical connector 45. The tubing string 20 conducts energized fluids.

Hence, contrary to the examiner's characterization of Bayh, the electrical connector 45 is not removably fixed to the tubing string 20 and the conductors 88, 89, 91 are not held in a spaced-apart disposition across the tubing string 20. Moreover, the electrical connector 45 disclosed in Bayh provides a mechanical link between the cable anchor assembly 40 and the locking module assembly 60, and an electrical link between the power cable 30 and the electric motor 50.

The wire guard 10 taught by Kramer is not capable of mechanically linking the cable anchor assembly 40 and the locking module assembly 60 or electrically linking the power cable 30 and the electrical motor 50. Hence, replacing the electrical connector 45 of Bayh with the wire guard 10 of Kramer, as proposed by the examiner on page 5 of the examiner's answer, would render the Bayh system inoperable for its intended purpose, and therefore, the combination of Bayh and Kramer is not supported by motivation.

In further regard to the lack of motivation to combine Bayh and Kramer, the examiner now states that Kramer teaches a wire guard for use in a well casing that conducts energized fluids, even though Kramer is silent on this issue. In support of this statement, the examiner appears to rely on definitions for the terms "well", "casing", and "pump" obtained from "Ask

Jeeves” Web Site. Based on this, the examiner apparently contends that there is motivation for combining the teachings of Bayh and Kramer, since they both are directed to the same type of conduits.

Appellant submits that the Kramer wire guard is utilized in a well casing that most likely does not conduct energized fluids. This is because in Fig 1, the top opening of the well casing 12 is shown closed with an access closure. Only pipes 11 and 16 appear to conduct energized fluid in Kramer. Thus, it is doubtful that one of ordinary skill in the art would interpret the well casing in Kramer to be of the type which conducts energized fluids.

Additionally, the Kramer wire guard utilizes a light duty fastening arrangement formed by a plurality of radially projecting tabs 32 that engage the wall surface of the well casing 12. Such a fastening arrangement does not appear useable in conduits that conduct energized fluids because the forces of the passing fluids are likely to dislodge the tabs 32 from the surface of an energized-fluid conduit.

In view of the foregoing it is doubtful that one of ordinary skill in the art would be motivated to use the Kramer wire guard in the Bayh tubing string.

Regarding the failure of Bayh in view of Kramer to teach or suggest the claim limitations of claim 4, the examiner’s answer states that “the claim limitations are met because the applicant hasn’t specified otherwise.” Bayh in view of Kramer fail to teach or suggest the subject matter of claim 4 because the examiner proposes that the Kramer wire guard be substituted for the electrical connector of Bayh. The Kramer wire guard does utilize nor require a threaded pipe coupler because it employs a pipe coupler formed by a cylindrical inner ring 21 having a split 23 and a hinge 24, which together, allow the ring to be open and closed, and locking elements 34 and 37 with cooperating locking teeth 35 and 38 that lock the ring 21 in the closed position.

Regarding the failure of Bayh in view of Kramer to teach or suggest the claim limitations of claim 7, the examiner may not rely upon the Bayh electrical connector 45 and its electrical penetrators 128, 129, & 130 to reject claim 7 when the examiner rejects the subject matter of claim 1, by replacing the electrical connector 45 of Bayh with the wire guard 10 of Kramer.

Moreover, Bayh in view of Kramer fail to teach or suggest means engaged with the cables for strain-relieving the cables. The electrical penetrators 128, 129, 130 relied upon by the examiner appear to function as electrical contacts for the electrical conductors 88, 89, and 90. There is no disclosure in Bayh that electrical penetrators function to strain-relieve the conductors.

Further, the threaded joints between the sections, that are now relied upon by the examiner for the strain-relieving means, are not engaged with the electrical conductors.

In view of the foregoing, a *prima facie* case of obviousness of the present invention has not been established using Bayh in view of Kramer. Accordingly, claims 1-9 are not unpatentable under 35 USC §103(a) over Bayh in view of Kramer.

II. CONCLUSION

It has been shown that the claimed invention distinguishes over the express and implied teachings of the prior art cited of record in the application, and in particular, distinguishes over the express and implied teachings of Bayh in view of Kramer. Hence, the appellant respectfully

requests that the Board reverse the examiner and direct that the application proceed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Schwarz', written over the typed name.

PAUL A. SCHWARZ, Esq.
Reg. No. 37,577

Paul A. Schwarz, Esq.
Duane Morris LLP
100 College Road West, Suite 100
Princeton, New Jersey 08540
(609) 919-4408
(609) 919-4401 – facsimile